

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Alexander Hauk et al.

Application No.: 10/595,702

Confirmation No.: 5037

Filed: May 5, 2006

Art Unit: 1621

For: METHOD FOR THE PRODUCTION OF
FORMIC ACID FORMATES

Examiner: P. A. Zucker

STATEMENT OF THE SUBSTANCE OF INTERVIEW

MS Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

Applicants appreciate the courtesies extended to Applicants' representative by Examiner Zucker during the October 30, 2009 personal interview. The following remarks constitute Applicants' separate record of the substance of interview.

As appreciated by the Examiner, U.S. Patent Application Publication No. US 2003/0092939 to Strofer et al. cannot reasonably be considered to suggest features corresponding to liquid streams I and II are mixed in the rectification column, as recited in independent claim 1. Instead, Strofer teaches, at Fig. 2, that formic acid and metal formate are fed into mixer 8 via feedline 5 and the outlet line of reactor 7, respectively.

During the October 30 interview, Examiner Zucker asserted that Strofer teaches static mixers as preferred embodiments of mixer 8 in Fig. 2. Further, the Examiner asserted that the packing material in a distillation column would perform the same function as a static mixer. Applicants respectfully submit that, as set forth at MPEP 2144.06 II., to rely on equivalence as a

rationale supporting an obviousness rejection, the equivalency must be recognized in the prior art, and cannot be based on Applicant's disclosure or the mere fact that the components at issue are functional or mechanical equivalents. *In re Ruff*, 256 F.2d 590, 118 USPQ 340 (CCPA 1958).

Strofer teaches, at paragraph [0032], that the reaction solution is separated within the distillation column into metal formate and water/catalyst. Strofer fails to teach that a distillation column may be used to mix liquids. As such, there is no indication in Strofer that a distillation column may be used to mix the metal formate feed and the formic acid feed. In fact, Strofer is utterly void of any suggestion that a distillation column achieves anything but a separation.

Moreover, there is no recognition in Strofer that the separating step b) and the formic acid adding step c) may be conducted simultaneously or at the same place. Instead, Strofer teaches, at paragraph [0063], that the individual process steps are carried out in the time sequence a), c), and b). As such, Strofer teaches away from the proposed removal of mixer 8 suggested in the Office Action because Strofer requires that for any given volume of formic acid feed, the addition and mixing to the metal formate feed is completed before distillation occurs. The proposed modification of Strofer in the Office Action, however, allows for distillation to occur before mixing is completed.

In view of the above, Applicants believe the pending application is in condition for allowance.

Applicants believe no fee is due with this response. However, if a fee is due, please charge our Deposit Account No. 22-0185, under Order No. 13156-00048-US1 from which the undersigned is authorized to draw.

Dated: December 3, 2009

Respectfully submitted,

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